REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 17-36 and 38-45 are currently pending, Claims 17, 19, 20, 21, and 23 having been amended. Claims 1-16 and 37 were canceled by previous amendments. The changes and additions to the claims do not add new matter and are supported by the originally filed specification, for example, in Figures 1-5.

In the November 12, 2010 Office Action, Claims 17, 19-21, and 23 were objected to for informalities; Claims 17, 19, 25, 31, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borthwick (U.S. Pub. No. 2003/0236836) in view of Ellson et al. (U.S. Patent No. 5,805,783, hereinafter "Ellson"); Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Borthwick in view of Ellson, and Rubstein et al. (U.S. Patent Pub. No. 2003/0061566, hereinafter "Rubstein"); Claims 20, 27, 28, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borthwick in view of Ellson, Abdel-Aziz et al. (U.S. Pub. No. 2004/0064511, hereinafter "Abdel-Aziz"), and Chan et al. (U.S. Patent No. 6,073,147, hereinafter "Chan"); Claims 21, 23, 26, 32-36, 43, and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borthwick in view of Ellson, and Abdel-Aziz; Claim 22 was rejected under § 103(a) as being unpatentable over Borthwick in view of Ellson, Abdel-Aziz, and Rubstein; Claim 24 was rejected under § 103(a) as being unpatentable over Borthwick in view of Ellson, Abdel-Aziz, Chan, and Rubstein; Claims 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borthwick in view of Ellson, Abdel-Aziz, Chan, and Khare ("Bitstream portable font resources for Web pages," 20 February 1997, retrieved from http://www.xent.com/FoRK-archive/winter96/0524.html on May 1, 2009) (hereinafter, "Khare"); Claims 38-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borthwick in view of Ellson, Abdel-Aziz, and Khare; Claim 45 was

rejected under § 103(a) as being unpatentable over Borthwick in view of Ellson and Aono et al. (U.S. Patent No. 2001/0007451, hereinafter "Aono").

With respect to the objection to Claims 17, 19-21, and 23, Applicants respectfully submit that at the present amendments to Claims 17, 19-21, and 23 overcome this ground of objection. In the present response, Claims 17, 19-21, and 23 have been amended to address the issues noted in the Office Action at page 12.

With respect to the rejection of Claim 20 under 35 U.S.C. § 103(a), Applicants respectfully traverse this ground of rejection and further submit that the present amendments to Claim 20 overcome this ground of rejection. Amended independent Claim 20 recites, *inter alia*,

> a first terminal to create 3D character mail by generating control information about a 3D font for expressing an input text message, and to transmit the text message and the generated control information to a second terminal without transmitting information related to the 3D character mail to a server, said control information being independent of the 3D font and including parameters for animating and creating a display appearance of the 3D font; and
>
> said second terminal to specify a 3D font necessary for reproducing the 3D character mail on the basis of the text message and the control information received from said first terminal, ***to download the specified 3D font from said server***, and to reproduce the 3D character mail on the basis of the text message and the control information received from said first terminal and the 3D font downloaded from said server.

In a non-limiting manner, Applicants' specification explains one advantage of these features. Applicants' specification states, at page 3, lines 14-21:

> According to the present invention, the system can be constructed with a high degree of flexibility in creation and reproduction of 3D character mail. Besides, it is possible to create highly original message contents with simple operations using limited resources of a terminal.
>
> Further, ***a 3D font*** and ***control information*** thereof are each handled as ***independent data*** as information for reproducing 3D character mail, and 3D character mail is reproduced by

> exchanging these data. Accordingly, the system configuration has a great potential for expansion. (Emphasis Added).

The Office Action acknowledges, at page 27, that Borthwick, Ellson, and Abdel-Aziz fail to teach all the features of Claim 20 directed to the second terminal, but asserts that Chan cures these deficiencies. In particular, the Office Action asserts that Chan teaches a second terminal to download the specified 3D font from said server, as recited in Claim 20.

Chan describes, in reference to Figure 3, a system which makes a determination as to whether the resources necessary to generate a font are stored at a computer (Step 26), and if the determination is No, a request is made to a font server 20.[1] Thereafter in Chan, a determination is made as to whether font data is stored in the server, and the font is retrieved if it is determined that the font is stored in the server.[2]

However, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine the teachings of Chan with the system of Borthwick to achieve a first terminal which transmits control information to a second terminal, and a second terminal which downloads the specified 3D font from the server, as recited in Applicants' Claim 20.

In Borthwick the recipient accesses and reads the unique text data string from the host server 120. In addition, Borthwick explains that the unique text data string represents all of the features of the entire rich media production, including fonts which have been imported or embedded into the production.

Thus, even if we were to assume that Chan teaches downloading a font from a server, one of ordinary skill in the art would not have been motivated to combine any alleged downloading of Chan with the system of Borthwick, where Borthwick teaches that the recipient already has access to the fonts through the unique text data string. In other words,

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[1] Chan, Fig. 3, col. 4, ll. 10-35, col. 5, ll. 35-51.
[2] *Id.*

one of ordinary skill in the art would not have been motivated to combine a teaching of retrieving or downloading a font if the font is already accessible.

Furthermore, Chan provides additional evidence that one of ordinary skill in the art would not have been motivated to combine the teachings of Chan with the system of Borthwick.

Chan describes that a request to retrieve a font is only sent *after* a determination is made that the font is not stored at the computer. In other words, because the unique text data string of Borthwick already provides the user with access to a font, and Chan describes that a font is only retrieved if it is not already stored, one of ordinary skill in the art would not have been motivated to combine any alleged retrieving or downloading in Chan with the system of Borthwick to achieve the features of Claim 20 directed to a first terminal which transmits control information to a second terminal and the second terminal which downloads the specified 3D font from the server.

Ellson, Abdel-Aziz, Rubstein, Khare, and Aono have been considered but fail to remedy the deficiencies of Borthwick and Chan with regard to amended Claim 20.

Thus, Applicants respectfully submit that the rejection of Claim 20 under 35 U.S.C. § 103(a) is overcome.

With respect to the rejection of Claim 17 under 35 U.S.C. § 103(a), Applicants respectfully traverse this ground of rejection and further submit that at least the present amendment to Claim 17 overcomes this ground of rejection. Amended Claim 17 recites, *inter alia*,

> a first terminal to create 3D character mail by generating instruction information for expressing an input text message using a 3D font without having the 3D font previously stored in the first terminal, to transmit the text message and instruction information to a server, and to transmit access path information associated with the 3D character mail, to a second terminal; and

> said server to store the 3D font, to generate control information about the 3D font for expressing the text message on the basis of the received instruction information, and to store the received text message and the generated control information as 3D message information independent from the 3D font, said control information being independent of the 3D font and including parameters for animating and creating a display appearance of the 3D font.

Turning to the primary reference, Borthwick describes a system for the design and sharing of rich media productions.[3] Borthwick explains that a creator uses author computer 110 to create the rich media production with files from locations, such as web sites.[4] In Borthwick the created rich media production is stored in an associated text record on a host computer 120, and thereafter, a recipient computer 140 may use the text record to recreate and access the rich media production.[5]

In addition, Borthwick explains that the author computer 110, includes a writer template which provides the core functionality for the creation of the rich media production and provides a vehicle for author computer 110 to communicate with host server 120.[6] Borthwick further explains that after the rich media production is created, a message with the URL that is associated with the production, may be sent to recipients.[7] When the email is sent in Borthwick, a unique text data string, representing all the features of the entire rich media production, is stored on the host computer 120.[8] Furthermore, Borthwick describes an animation menu that may be imported into the writer template and used to affect the appearance and behavior of the selected text box.[9]

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[3] Borthwick, Title.
[4] *Id.* at [0025].
[5] *Id.*
[6] *Id.* at [0026].
[7] *Id.* at [0056].
[8] *Id.*
[9] *Id.* at [0049].

The Office Action apparently asserts, at pages 13-14, that the author computer 110 of Borthwick corresponds to the first terminal of Claim 17, and that the embedded font file of Borthwick corresponds to the instruction information of Claim 17.

However, Applicants respectfully submit that Borthwick fails to teach at least a first terminal to create 3D character mail by generating instruction information for expressing an input text message using a 3D font ***without having the 3D font previously stored in the first terminal***. By contrast, Borthwick merely describes a font menu is used to insert text into a writer template at the author computer 110, and allows the user to set the font type and other characteristics. Borthwick explains that the user imports an embedded font file of editable text as a text box. In other words, in Borthwick the font is stored in the author computer 110 before the characteristics of the font are set. Thus, even if we were to assume that the author computer 110 of Borthwick corresponds to the first terminal of Claim 17, and that the embedded font file of Borthwick corresponds to the instruction information of Claim 17, Borthwick still fails to teach at least a first terminal to create 3D character mail by generating instruction information for expressing an input text message using a 3D font ***without having the 3D font previously stored in the first terminal***, as required by Applicants' Claim 17.

In addition, the Office Action asserts, at the section entitled "Conclusion" on page 11, that Borthwick in view of Ellson teaches the features of Claim 17. However, Applicants respectfully traverse this assertion, as next discussed.

In regard to the assertions in the Office Action at section (A), Applicants respectfully note that in Borthwick it is unclear as to whether or not the "font file(s)" itself to be imported can be referred to as a "font." In Borthwick the term "font file(s)" appears only four times in paragraph [0047]. Borthwick merely describes the following: it is used to insert text in writer template 100; it is embedded in a editable text, and imported as a text box; it is associated

with a "container object;" and it has the properties of the user-selected style and justification as determined in the menu selections.

Therefore, in Borthwick it is unknown where the font file(s) is. Moreover, in Borthwick it is unclear if "container object" indicates font.

Although paragraph [0047], lines 12-14, of Borthwick states "[t]he text box is designed to produce the embedded font that matches the font selected by the user from the menu," it cannot be consider that "the embedded font" is a misdescription of "the embedded font file" (since the text box "produces" the "font"). Thus, in Borthwick it is unclear as to whether the "embedded font file" is the "font."

For the aforementioned reasons, Applicants respectfully submit that accessing by the font file to a menu in order for the font file to be used to insert text into the writer template 100 of Borthwick does not correspond to said second terminal ***to access said server*** on the basis of the access path information received from said first terminal, and ***to download*** the 3D message information and ***corresponding 3D font***, as recited in Claim 17.

In addition, although Borthwick describes steps of designing and sharing a rich media production, it does not refer to 3D CG elements, but states that "the text data string represents all the features of the entire rich media production." (Borthwick paragraph [0056]). Therefore, Borthwick is not an efficient way of sharing a production from a point of view of data transmission.

Furthermore, although Ellson may refer to an introduction of 3D CG elements in rich media production, Ellson does not consider a step of sharing as in Borthwick. Thus, Applicants respectfully submit that even if we were to combine, *in arguendo*, the teachings of Ellson with the teachings of Borthwick any resulting combination would still fail to teach the features of Claim 17 directed to a server configured to store the received text message and the

generated control information as 3D message information, and a second terminal to download the 3D message information and corresponding 3D font.

Applicants respectfully submit that any resulting combination of Borthwick and Ellson would merely describe an inefficient system of sending and receiving a huge data set including attribute of 3D CG data.

In regard to the assertions in the Office Action at section (B), as mentioned above, paragraph [0047] of Borthwick describes that a font file is stored in editable text and imported as a text box. Thus, if the font file of Borthwick should refer to font itself in view of section (A) in the Office Action, Applicants respectfully submit that the assertions under section (B) of the Office Action have no grounds, because this would mean that the font and editable text are not independent.

That is, if the font file in Borthwick refers to the font itself, the assertions in section (B) of the Office Action would be improper (since it cannot be said that control information is independent from the font), and if the font file of Borthwick does not refer to the font itself, the assertions in section (A) of the Office Action would be unreasonable.

Applicants respectfully submit that Borthwick, which describes a "design" step of a rich media production, fails to teach at the features of Claim 17. Rather, the variety and efficiency of the system would depend on <how each of the elements configuring the production is arranged in the step of "sharing">. Therefore, even if we were to assume that Borthwick and Ellson could be combined, the resulting combination is merely a inefficient system, as stated above.

Abdel-Aziz, Chan, Rubstein, Khare, and Aono have also been considered but fail to remedy the deficiencies of Borthwick and Ellson with regard to amended Claim 17.

Thus, Applicants respectfully submit that the rejection of Claim 17 under 35 U.S.C. § 103(a) is overcome.

With respect to the rejection of Claim 23 under 35 U.S.C. § 103(a), Applicants respectfully traverse this ground of rejection, as next discussed.

In regard to the assertions in the Office Action at section (C), Applicants respectfully traverse these assertions. The Office Action asserts, at page 9, that the animation property is independent from font based on the fact that there is no disclosure in Borthwick that the animation property depends on some font. However, Applicants respectfully submit that this logic is unclear. For example, the fact that there is no disclosure in Borthwick that the animation property depends on some font, does not suggest that the animation property is independent from the font, but merely indicates that Borthwick is silent to this relationship.

Moreover, in regard to the assertion in the Office Action at section (D), the present amendment to Claim 23 clarifies that said second terminal stores the 3D font before receiving the text message and control information from the first terminal. Thus, even if we were to assume, as the Office Action asserts, that the reading out text data string as in Borthwick describes storing font, Borthwick still fails to teach at least the features of Claim 23.

Thus, Applicants respectfully submit that the rejection of Claim 23 under 35 U.S.C. § 103(a) is overcome.

With respect to the rejection of Claim 19 under 35 U.S.C. § 103(a), Applicants respectfully traverse this ground of rejection. Independent Claim 19 recites, *inter alia*,

> a first terminal to create 3D character mail by generating control information about a 3D font for expressing an input text message, to store the 3D font, to transmit the text message, the generated control information, and the 3D font used to express the text message, to a server, and to transmit access path information associated with the 3D character mail, directly to a second terminal, said control information being independent of the 3D font.

The Office Action asserts, at pages 17-19, that the author computer of Borthwick corresponds to the first terminal of Claim 19, that the recipient of Borthwick corresponds to

the second terminal of Claim 19, and that the unique HTML page of Borthwick corresponds to the access path information of Claim 19.

However, Applicants respectfully submit that Borthwick fails to teach at least a first terminal to transmit access path information associated with the 3D character mail, ***directly to a second terminal***. By contrast, Borthwick merely describes that after the creator creates the rich media production, the middleware software 128 of the host server generates and sends an email, that contains the unique URL, to the recipient.[10] In other words, in Borthwick the host server sends access information to the recipient. Thus, even if we were to assume that the author computer of Borthwick corresponds to the first terminal of Claim 19, the author computer of Borthwick does not transmit access path information associated with the 3D character mail, ***directly to a second terminal***.

Ellson, Abdel-Aziz, Rubstein, Chan, Khare, and Aono have been considered but fail to remedy the deficiencies of Borthwick with regard to amended Claim 19.

Thus, Applicants respectfully submit that the rejection of Claim 19 under 35 U.S.C. § 103(a) is overcome.

With respect to the rejection of Claim 21 under 35 U.S.C. § 103(a), Applicants respectfully traverse this ground of rejection. Independent Claim 21 recites, *inter alia*,

> a first terminal to create 3D character mail by generating control information about the 3D font for expressing an input text message, to store the 3D font, and to transmit the text message, the generated control information, and the 3D font used to express the text message, directly to a second terminal, said control information being independent of the 3D font and including parameters for animating and creating a display appearance of the 3D font.

Turning to the primary reference, Borthwick describes an author computer that creates a rich media production and a host server that stores the rich media production.

[10] Borthwick, [0056].

However, Applicants respectfully submit that Borthwick fails to teach at least a first terminal to transmit the text message, the generated control information, and the 3D font used to express the text message, ***directly to*** a second terminal. By contrast, in Borthwick a host server provides access to the unique text data string. Thus, even if we were to assume, *in arguendo*, that the author computer of Borthwick corresponds to the first terminal of Claim 21 and that the unique data text string corresponds to the control information of Claim 21, Borthwick still fails to teach a first terminal to transmit the text message, the generated control information, and the 3D font used to express the text message, ***directly to*** a second terminal. By contrast, in Borthwick such data is not transmitted directly to a recipient from the author computer.

Ellson, Abdel-Aziz, Rubstein, Chan, Khare, and Aono have been considered but fail to remedy the deficiencies of Borthwick with regard to amended Claim 21.

Thus, Applicants respectfully submit that the rejection of Claim 21 under 35 U.S.C. § 103(a) is overcome.

Furthermore, regarding the references in the Office Action to external servers in Rubstein, Abdel-Aziz, and Chan, Applicants note the following.

Although each of Rubstein, Abdel-Aziz, and Chan, refers to sharing mediated by a server as a third composition element to Borthwick and Ellson, and Rubstein suggests existence of a third server by presenting server URLs, what is designated by these URLs is merely a link as in Borthwick in which contents including all composition elements are allocated.

Thus, in the system in Rubstein, the fact is that simply the third server is physically added, and rich media contents which are sent/received are neither distributed nor delivered effectively.

In Abdel-Aziz, a system in which, without a server as a third party, data is exchanged with a sender/receiver as server clients is suggested, however, as to source distribution regarding contents to be sent/received, it is not referred to at all. Therefore, the same arguments as in Rubstein also apply to Abdel-Aziz.

Chan teaches a system for obtaining font data to be displayed from an external server when those font data are not included in a receiving terminal. However, in Chan what is described is only that when necessary two-dimension font data is "lost" in a local terminal, the data is supplied by referring to a server.

Accordingly, even if we were to assume that Chan could be combined with Borthwick and Ellson, the resulting combination would merely describe a huge data set which covers all expressions including 3D CG flows back and forth between terminals, and as to the lost data, the combination only suggests a system that the lost data is supplied via an external server.

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for allowance. Therefore a Notice of Allowance for Claims 17-36 and 38-45 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place the present application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below-listed telephone number.

Respectfully submitted,

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